



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY, COUNSEL OR AGENT
09/265,669	03/10/99	MAKITA	AS 251002009000

IM22/0908  
MORRISON & FOERSTER  
2000 PENNSYLVANIA AVENUE N.W.  
WASHINGTON DC 20006-1888

EXAMINER  
SHEEHAN, J

ART UNIT	PAPER NUMBER
1742	7

DATE MAILED: 09/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/265,669

Applicant(s)

Makita et al.

Examiner

John P. Sheehan

Group Art Unit

1742



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-43 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-43 are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 to 4, 12 to 16, 18 to 23 and 25 to 30, drawn to a permanent magnet having a ferromagnetic phase and a grain boundary phase wherein the ferromagnetic phase is matched with the grain boundary phase, classified in class 148, subclass 300.
  - II. Claims 5 to 7, drawn to a permanent magnet wherein the outermost shell of the ferromagnetic grains has a magnetocrystalline anisotropy not less than one half the magnetocrystalline anisotropy of the interior of the ferromagnetic grains, classified in class 148, subclass 300.
  - III. Claims 8 to 10, drawn to a rare earth containing permanent magnet wherein cations are located in the grain boundary phase neighboring to the rare earth element ions located at an outermost shell of the ferromagnetic grains and the method of making the same, classified in class 148, subclass 301.
  - IV. Claims 11, 17 and 24, drawn to a method of making permanent magnets comprising setting the composition of the grain boundary phase so that it will be matched with the ferromagnetic phase, classified in class 148, subclass 101.

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- V. Claim 31, drawn to a method of making rare earth-transition metal-boron-oxygen permanent magnet containing a  $R_2TM_{14}B$  phase and a R-TM-O phase, classified in class 148, subclass 101.
- VI. Claims 32 to 37, drawn to rare earth magnetic powders containing an alkaline earth metal and a  $R_2TM_{14}B$  phase, classified in class 148, subclass 302.
- VII. Claims 38 to 43, drawn to a method of making a rare earth containing magnetic powder containing an alkaline earth metal and a  $R_2TM_{14}B$  phase, classified in class 148, subclass 101.

2. The inventions are distinct, each from the other because of the following reasons:

3. The Groups I, II, III and VI are each directed to various permanent magnet materials.

These groups of inventions are distinct in that they are capable of separate manufacture, use, or sale as claimed and are patentable (novel and unobvious) over each other (though they may each be unpatentable because of the prior art), MPEP 802.01.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. The Groups IV, V and VII are each directed to various methods of making several permanent magnet materials. These groups of inventions are distinct in that they are capable of

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separate manufacture, use, or sale as claimed and are patentable (novel and unobvious) over each other (though they may each be unpatentable because of the prior art), MPEP 802.01.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Inventions IV, V and VII and inventions I, II, III and VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case that the product as claimed can be made by another and materially different process, that is, it is only reasonable and plausible that there are alternate methods of making the claimed permanent magnet materials.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the searches required for the above grouped inventions are not co-extensive, restriction for examination purposes as indicated is proper.

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7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

9. *Priority*

10. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner John P. Sheehan, whose telephone number is (703)-308-3861. The examiner can normally be reached on Tuesday-Friday from 6:30 A.M.-5:00 P.M.

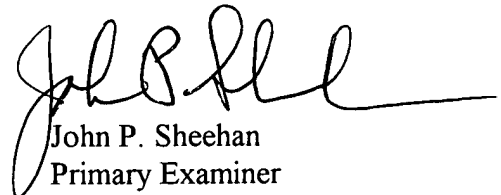
The fax phone number for this Technology Center is (703)-305-3599.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

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When filing a FAX in Technology Center, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

jps  
September 8, 2000



John P. Sheehan  
Primary Examiner  
Art Unit 1742